

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, has rejected all remaining claims 1-20 under 35 U.S.C. § 103(a), using a variety of combinations of references. Applicants have amended claims 1, 3, 11 and 13 to more clearly define novel and non-obvious aspects of the claimed embodiments. No new matter is added to the application by these amendments.

Claim 1

The Office Action rejected independent claim 1 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. published application 2004/0080684 to Rho in view of U.S. patent 6,573,969 to Watanabe et al. Amended claim 1 recites, among other features, “*a transparent organic planarization layer* formed on the color filter” (*emphasis added*). Furthermore, an embodiment of the organic transparent planarization layer is a *benzocyclobutene (BCB) resin* or *an acryl resin*, as recited in claim 3.

The Office Action admits that Rho does not teach a planarization layer formed on the color filter, but alleges that Watanabe teaches a liquid crystal display with a planarization layer between the color filter and upper electrode creating a smooth surface. Significantly, however, neither Rho nor Watanabe, single or combination thereof, teaches limitations of the *transparent organic planarization layer* formed on the color filter (*emphasis added*). For at least this reason, claim 1 defines over the cited art and the rejection should be withdrawn.

It is therefore submitted that amended claim 1 is patentable. Since claims 2-10 directly or indirectly depend from amended claim 11, claims 2-10 are patentable by virtue of their dependency from patentable amended claim 1.

In addition, the combination fails to teach or suggest that the organic transparent planarization layer is a *benzocyclobutene (BCB) resin* or *an acryl resin*, as further recited in claim 3, and for this independent reason the rejection to claim 3 should be withdrawn.

Claim 11

The Office Action rejected independent claim 11 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of U.S. patent 6,633,353 to Seki et al. in view of Rho and U.S. patent 6,424,397 to Kuo et al. Amended claim 11 recites, among other features, “**a color filter having various thicknesses** formed on the lower electrode” and “***a transparent organic planarization layer*** formed on the color filter” (*emphasis added*). Furthermore, an embodiment of the organic transparent planarization layer is a ***benzocyclobutene (BCB) resin*** or ***an acryl resin***, as claimed in claim 13.

The Office Action admits that Seki fails to disclose a color filter having various thicknesses, but alleges that Rho teaches a color filter having various thicknesses and a planarization layer formed on the color filter. The Office Action also alleges that Watanabe teaches a liquid crystal display with a planarization layer between the color filter and upper electrode creating a smooth surface. Significantly, however, none of Seki, Rho, or Watanabe, either alone or in combination teaches or suggests that feature of the **transparent organic planarization layer** formed on the color filter (*emphasis added*), as defined in amended claim 11. For at least this reason, claim 11 defines over the cited art and the rejection should be withdrawn.

It is therefore submitted that amended claim 11 is patentable. Since claims 12-20 directly or indirectly depend from amended claim 11, claims 12-20 are patentable by virtue of their dependency from patentable amended claim 11.

In addition, the combination fails to teach or suggest that the **organic transparent planarization layer** is a ***benzocyclobutene (BCB) resin*** or ***an acryl resin***, as further recited in claim 13, and for this independent reason the rejection to claim 13 should be withdrawn.

For all of these reasons, Applicants submit that this application is now in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

In addition, Applicants respectfully submit that the Office Action failed to cite or identify

proper motivations for combining the selected features from the various references. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a transfective LCD device as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was is motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is not apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

Various rationales for combining selected teachings have been advanced in the Office Action. As one example (see rejection of claim 5, top of page 6 of the Office Action), the Office Action stated that “it would have been obvious [to combine Rho and Watanabe and U.S. patent 6,033,813, and U.S. patent 6,426,166 merely] to use positive photoresist color filter to make a fine color filter and use positive photolithography techniques as required by the positive photoresist material.” Applicants respectfully disagree, and submit that such a conclusory

allegation fall far short of the legal requirement for combining selective teachings from a variety of references, and is particularly tenuous to support a combination of four distinct references.

However, in view of the substantive distinctions made with respect to the independent claims, Applicants need not further discuss the lack of motivation to combine for the various claims, as such a discussion is superfluous to this response. Suffice it to say that Applicants disagree with the various motivations and rationales advanced by the Office Action for combining the various references.

No fee is believed to be due in connection with this amendment and response. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to Deposit Account No. 20-0778.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Daniel R. McClure', written over a horizontal line.

Daniel R. McClure
Registration No. 38,962

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500